

**REMARKS**

Applicant amended claim 32 to clarify that the purchaser is an intermediate purchaser (i.e., an intermediary between the user and the vendor) and that the intermediate purchaser purchased from the vendor at least one certificate, with each of the at least one certificate having a first average price. Applicant further amended claim 32 to recite that the user bought from the purchaser one of the at least one certificate at a second price that is greater than the first price. Support for these amended features is provided, for example, at paragraph 52 on pages 4-5 of Pre-Grant Patent Publication No. 2002/0103723 corresponding to the above-identified application, and at paragraphs 83-84 on page 7 of the above-identified publication. Additionally, applicant amended dependent claims 33, 35-36 and 38 to make the language recited therein consistent with the amended language of independent claim 32. Applicant also cancelled, without prejudice, claim 37. Applicant added new claim 39, depending from claim 34, reciting the feature that the online product includes generating an on-line tribute for a deceased person. Support for this feature is provided, for example, at paragraph 48 on page 4 of the above-identified publication. Applicant also added new claim 40, depending from claim 32, reciting that the average first price is zero. Support for this feature is provided, for example, at paragraph 52 on page 5 of the above-identified publication

After these amendments, claims 32-36 and 38-40 are pending, with claim 32 being independent.

The examiner rejected claims 32, 33, 37 and 38 under 35 U.S.C. §103(a), as allegedly being unpatentable over U.S. Patent No. 6,370,514 to Messner in view of U.S. Patent Publication No. 2001/0007098 to Hinrichs.

The examiner rejected claim 34 under 35 U.S.C. §103(a) as allegedly being unpatentable over Messner in view of Hinrichs and further in view of U.S. Publication No. 2003/0212611 to Barrot.

The examiner rejected claim 35 and 38 under 35 U.S.C. §103(a) as allegedly being unpatentable over Messner in view of Hinrichs and further in view of Dixon.

Applicant's independent claim 32 recites "receiving entry of said authorization code on a web site via which said online product can be obtained, wherein said authorization code is entered on said web site by a user that bought from said intermediate purchaser one of the at least

one certificate at a second price that is greater than the first price". As explained in applicant's specification:

The certificate for the online product contains a unique authorization code. The authorization code is associated with characteristics that are recorded for tracking purposes. For example, these characteristics include the identity of the entity that is to provide the certificate to a user (e.g., the purchaser), information relating to this entity, how much the certificate was sold for, to whom the certificate was sold, the date the certificate was sold, what type of certificate it is (e.g., a free certificate, non-free certificate, or free option certificate), information relating to the user of the certificate, and/or the like. A purchaser buys one certificate or a large quantity of certificates in bulk. For example, a purchaser can buy a plurality of certificates at a reduced rate from the system, and then sell the certificates to users at a profit. Alternatively, the purchaser is given certificates by the system to provide to users (such as non-free certificates). The purchaser sells the certificates to users, which could be at no charge. Alternatively still, the purchaser and the user are the same entity, such that the purchaser is the user that redeems the certificate(s). Alternatively still, the purchaser and user are different entities. (emphasis added,, paragraph 52, pages 4-5 of Pre-Grant Patent Publication No. 2002/0103723)

Thus, the price paid by a user to the intermediate purchaser is higher than the price paid by the intermediate purchaser to the original vendor.

In contrast, none of the references relied upon by the examiner to reject independent claim 32 discloses or suggests at least the features of "receiving entry of said authorization code on a web site via which said online product can be obtained, wherein said authorization code is entered on said web site by a user that bought from said intermediate purchaser one of the at least one certificate at a second price that is greater than the first price," required by independent claim 32.

Particularly, Messner describes methods for mass, nationwide distribution of vouchers for redemption at a specific merchant/virtual mall, or on the Internet as a whole via a computer network (Messner, col. 1, lines 21-24). Messner explains, for example:

As shown in FIG. 1, A purchaser 90 first chooses a method for the purchase of the gift certificate 100. A purchaser 90 can purchase a gift certificate 100 either over the phone, at a brick and mortar store 98, at a virtual mall 94, a merchant web site 30, or at the voucher server web site 54. It is strongly preferred, however, regardless of the means of purchasing the certificate, that the purchase be processed through the voucher server 54.

...

The purchaser 90 may be able to specify the goods or services he wishes to appear on the gift certificate 100. Specifying the goods or services the

purchaser 90 wishes to highlight may present technical problems, particularly since some merchants do not allow their web pages to be "framed." Framing involves allowing the viewing of two unrelated web pages simultaneously. In this case, the voucher server 54 would frame the merchant's web page, and a purchaser 90 would navigate to the desired web page on the merchant's site, then record his choice on the voucher server page which surrounds (i.e., frames) the merchant's page. Another method, simpler for the system administrator, but more complicated for the purchaser 90 requires the purchaser to copy the address of the desired page, then to paste type or paste it into the appropriate data field in the certificate order form. However, technical issues notwithstanding, it is desirable to offer the purchase 90 the option of specifying particular goods/services for consideration by the recipient 92.

The purchaser 90 also may be able to specify whether he wants the purchase to be anonymous and/or a "surprise." If the purchaser elects to make the certificate 100 to be anonymous, the recipient 92 will not be notified who the certificate is from until the recipient "opens" the certificate. If the purchaser 90 elects to make the certificate 100 a surprise, the recipient 92 will not know the amount nor the merchant(s)/mall(s) until he opens the certificate. If a certificate 100 is delivered electronically (e.g., by e-mail), it will preferably be "opened" by selecting (i.e., double mouse clicking) an icon on the e-mail which, for example, looks like a wrapped package. (Col. 7, line 51 to col. 8, line 46)

Thus, Messner fails to describe that a recipient acquires a certificate in a physical form from a purchaser (e.g., engaging in a commercial transaction with the purchaser). Messner certainly does not describe that the recipient buys the certificate at a price that is higher than the average price paid for the certificate(s) by the purchaser who purchased those certificate(s) from the merchant. Accordingly, Messner fails to disclose or suggest at least the features of "receiving entry of said authorization code on a web site via which said online product can be obtained, wherein said authorization code is entered on said web site by a user that bought from said intermediate purchaser one of the at least one certificate at a second price that is greater than the first price," as required by independent claim 32.

Hinrichs describes gift certificate award and redemption programs, for example, programs in which an employer awards employees using gift certificates (Hinrichs, page 3, paragraph 3). Hinrichs explains, for example:

[0012] The present invention provides a versatile and efficient system that monitors employees anniversaries. An e-mail system is used to send the award letter, and the internet is used to allow access to a premium catalog and choice of a premium award. Additionally, or alternatively, the internet is used to enable shopping at various merchants' web sites.

[0013] According to one embodiment, the recognition e-mail is generated in a manner to appear as if it was generated and sent by the employee's

manager. Additionally, the recognition e-mail includes a hyperlink to a web site that includes a catalog of the premiums available to the employee. While the premium catalog is structure with multiple levels of awards, the hyperlink allows the user to access only the catalog pages appropriate to the anniversary level the employee has achieved.

[0014] According to another embodiment, the award or gift email includes a hyperlink to a shopping cart, and an award account is established at the shopping cart. The shopping cart allows access to various merchants shopping sites, while the shopping cart acts as a proxy for communication between the user and the merchants' sites. When the user places a purchase order, the order is intercepted by the shopping cart and stored. When the user completes shopping, all the purchase order are processed against the award account of the user. (Emphasis added, Hinrichs, pages 1-2, paragraphs 12-14)

Hinrichs also explains, for example:

[0065] The shopping cart 810 is particularly advantageous for use in conjunction with the award program described above, which can be appreciated from the following example. User 800 receives an award email, from employer 840 for example, which includes a gift certificate and an award code. User 800 then logs onto shopping cart 810 and enters the award code. Shopping cart then verifies the code and, if valid, establishes or associates an award account for user 800. The user may then click on any of the merchants' icons displayed at shopping cart 810 and shop at any of the merchants' sites. The shopping would be conducted with the shopping cart acting as a proxy, as explained above. When the shopping cart recognizes a "buy" order from the user 800, the shopping cart sends a request to user 800 to input shipping address, shipping method etc. The shopping cart then totals the amount of purchase and deducts it from the award credit available to user 800, and displays it to the user. Additionally, the shopping cart fetches from the fields database the appropriate fields for order placing with the selected merchant. Shopping cart 810 inserts the shipping address and quantity obtained from user 800, but in the charge field it doesn't insert charging information of user 800, but rather that of the entity issuing the gift certificate, or of the shopping cart company itself In this manner, the gift certificate can be used at any merchant or combination of merchants and is not limited to a single issuing merchant.

[0066] Moreover, since the shopping cart monitors the award accounts and knows when a certificate has been used, it can automatically generate and send reports to the entity providing the gift certificates, such as employer 840. That is, for each manager of company 840, shopping cart 810 can issue a report relating to the account activities which can include redemption of gift certificates. In this manner, the manager can more efficiently manage the gift account. (Hinrichs, page 6, paragraphs 65-66)

Thus, Hinrichs systems enables users to access a service provider site that acts as a proxy to communicate with merchants' sites. But nowhere does Hinrichs describe that gift certificates, in a physical form, were purchased by an intermediary purchaser (be it the "shopping cart" service provide, employer, or otherwise) and then sold to the employee at a price higher than

what was paid for the gift certificates at the first place. All Hinrichs indicates is that the employees receive the gift certificates (e.g., via e-mail) and can subsequently redeem those gift certificates via the “shopping cart” service provider. Accordingly, Hinrichs also fails to disclose or suggest at least the features of “receiving entry of said authorization code on a web site via which said online product can be obtained, wherein said authorization code is entered on said web site by a user that bought from said intermediate purchaser one of the at least one certificate at a second price that is greater than the first price,” as required by applicant’s independent claim 32.

Because neither Messner nor Hinrichs discloses or suggests, alone or in combination, at least the features of “receiving entry of said authorization code on a web site via which said online product can be obtained, wherein said authorization code is entered on said web site by a user that bought from said intermediate purchaser one of the at least one certificate at a second price that is greater than the first price,” applicant’s independent claim 32 and the claims depending from it are therefore patentable over the cited art.

Additionally, applicant further contends that no reason exists to combine Hinrichs with Messner, and that for this reason too, independent claim 32 is patentable over the cited art.

In *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 2007 (Apr. 30, 2007), the Supreme Court reversed a decision by the Court of Appeal’s for the Federal Circuit decision that reversed a summary judgment of obviousness on the ground that the district court had not adequately identified a motivation to combine two prior art references. The Court noted:

“As is clear from cases such as *Adams* [citation omitted] a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” (Emphasis added, pages 14-15)

As explained, Messner describes redemption of certificates previously acquired from a merchant (e.g., an on-line merchant) in which “the recipient 92 [party redeeming the certificate]

first connects to the appropriate merchant/mall web site or to the voucher server 54 directly” (Messner, col. 9, line 67 to col. 10, line 2). In stark contrast, Hinrichs describes distribution of employee gift awards, e.g., through e-mail, and enabling recipient employees to access a proxy server through which they may redeem their awards, and notes “the award or gift email includes a hyperlink to a shopping cart, and an award account is established at the shopping cart. The shopping cart allows access to various merchants shopping sites, while the shopping cart acts as a proxy for communication between the user and the merchants' sites.” (Hinrichs, page 2, paragraph 14). Neither Messner nor Hinrichs articulates any reason to combine these disparate systems and methodologies disclosed respectively by Messner and Hinrichs.

Accordingly, for this reason too, applicant's independent claim 32 and the claims depending from it are patentable over the cited art.

It is believed that all the rejections and/or objections raised by the examiner have been addressed.

In view of the foregoing, applicant respectfully submits that the application is in condition for allowance and such action is respectfully requested at the examiner's earliest convenience.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

Based on the foregoing, this application is believed to be in allowable condition, and a notice to that effect is respectfully requested.

If a telephone conversation with Applicants' attorney would help expedite the prosecution of this application, the Examiner is invited to call the undersigned Attorney at (617) 542-6000.

A petition for extension of time, Request for Continued Examination, and the corresponding fees accompany this response. The Commissioner is authorized to charge any additional fees that may be due, including a fee for extension of time, or to credit any overpayment, to the undersigned's account, Deposit Account No. 50-0311, Reference No. 36353-501.

Respectfully submitted,

Date: December 21, 2007



Ido Rabinovitch  
Reg. No. L0080

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.  
One Financial Center  
Boston, MA 02111  
**Customer No. 64046**  
Tel.: (617) 542-6000  
Fax: (617) 542-2241